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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/957,436	09/20/2001	Keiji Osano	7217/65454	3247

7590 12/06/2004

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EXAMINER

SAMS, MATTHEW C

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 12/06/2004

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/957,436

Applicant(s)

OSANO, KEIJI

Examiner

Matthew C. Sams

Art Unit

2643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/20/2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The information disclosure statement filed on 3/24/2004 has been considered.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Fig. 1 [24] and [28], Fig. 5 [82], Fig. 8B [11] and Fig. 8C [SL], [SR] and [S1]. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.
4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the

description: Fig. 5 [87], Fig. 6 [CP1] and [CP2], Fig. 7 [33] and [79], Fig. 8B [11], Fig. 8C [GND] and [FROM 75], Fig. 10A [11], Fig. 10B [FROM 75] and [C2], Fig. 11 [79] and Fig. 12 [86]. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-2 and 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Acree (US-5,099,514 herein after, Acree) in view of Adams (US-6,594,366 herein after, Adams).

Regarding claim 1, Acree discloses a telephone accessory that uses a headphone unit (Fig. 1 [12]), an amplifier for amplifying ambient sound (Fig. 2 [70 & 71]) and a control device for adjusting the signal level (Fig. 1 [42 & 43]) of the ambient sound. Acree differs from the claimed device in not specifically disclosing a handheld telephone set with a detecting means for a stereo or mono headphone type. However, Adams discloses a handheld telephone set (Fig. 1 [50]) with a circuit (Fig. 3 [201]) for detecting stereo/mono headphones (Fig. 1 [101 & 103]). (Col. 5 line 10-12 and Col. 6 lines 5-9) At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to prepare the telephone accessory (Fig. 1 [10]) of Acree integrated into a handheld telephone set with a detecting means for stereo/mono operation (Fig. 1 [101 & 103]) like Adams. One of ordinary skill in the art would have been motivated to do this since it makes it possible for the telephone accessory to be portable, to detect the presence of either a telephone headset or stereo headphones and provide either telephone functionality or radio functionality in response to their detection. (Adams Col. 1 lines 10-25 and 36-39)

Regarding claim 2, Adams discloses a handheld telephone set (Fig. 1 [50]) connected to stereo earphones (Fig. 1 [101]) or a mono earphone (Fig. 1 [103]). Depending upon which type of earphone is connected, an amplifier increases or decreases the signal level accordingly. (Col. 4 lines 54-57 and Col. 6 lines 5-9)

Regarding claim 5, Acree discloses an amplifier (Fig. 2 [70 & 71]) that superposes digital signals onto digital audio signals. (Col. 2 lines 35-37)

Regarding claim 6, Acree discloses an amplifier (Fig. 2 [70 & 71]) that superposes analog signals onto analog audio signals. (Col. 2 lines 35-37)

Regarding claim 7, Acree discloses a microphone (Fig. 1 [40]) for acquiring ambient sound. (Col. 1 lines 29-35)

Regarding claim 8, Acree discloses a telephone accessory that uses a headphone unit (Fig. 1 [12]), an amplifier for amplifying ambient sound (Fig. 2 [70 & 71]) and a control device for adjusting the signal level (Fig. 1 [42 & 43]) of the ambient sound. Acree differs from the claimed device in not specifically disclosing a handheld telephone set with a detecting and configuring means for a stereo or mono headphone type. However, Adams teaches of a handheld telephone set that detects stereo/mono headphones and amplifies the signals accordingly. (Col. 5 lines 10-12 and Col. 6 lines 5-9) At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to prepare the telephone accessory (Fig. 1 [10]) of Acree in a handheld telephone set (Fig. 1 [50]) with a means for detecting and configuring stereo/mono headphones (Fig. 1 [101 & 103]) like Adams. One of ordinary skill in the art would have been motivated to do this since it makes it possible for the telephone set to detect the presence of either a telephone headset or stereo headphones and provide either telephone functionality and/or radio functionality with optimal amplification levels in response to their detection. (Adams Col. 1 lines 10-25 and 36-39)

Regarding claim 9, the limitations of the claim are rejected as the same reason set forth in claim 2.

7. Claims 3-4 and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Acree and Adams as applied to claims 1 and 8 above, and further in view of Romesburg (US-5,966,438 herein after, Romesburg).

Acree and Adams disclose all of claims 1 and 8, which claims 3-4 and 10-11 are dependent upon. Acree and Adams differ from the claimed device in not specifically mentioning that the amplifier gain is controlled by feedback.

Romesburg teaches of a handheld telephone set (Col. 9 lines 56-57) that adjusts the amplifier gain (Fig. 6 [34]) according to the ambient sound detector, the microphone (Fig. 1 [120]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to prepare the telephone set of Acree and Adams with an adjustable amplifier gain controlled by feedback like that of Romesburg. One of ordinary skill in the art would have been motivated to do this since it makes it possible for hands free operation of the headphone with various levels of ambient noise without having to manually adjust the signal levels. (Col. 3 lines 34-36)

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited to further show the state of the art with respect to alert messages for mobile electronic devices in general:

US-6,728,374 to Takeda- Transmitter/receiver comprising a bone-conduction speaker.

US-5,535,433 to Kurokawa et al.- Hands-free circuitry featuring signal adjustment based upon speaker volume.

US-6,374,126 to MacDonald- Hands-free headset with storable stereo earpiece.

US-5,655,025 to Kim et al.- Circuit for automatically recognizing and receiving mono and stereo audio signals.

US-6,748,085 to Yang- Audio input that amplifies stereo and mono signals separately, distinctly and automatically.


JP-58-190,107 to Hironori- Circuit capable of delivering external sounds from a microphone to a headphone.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew C. Sams whose telephone number is (703)305-4718. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on (703)305-4708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MCS
9/22/2004


GEORGE ENG
PRIMARY EXAMINER